

REMARKS

Claims 1 - 60 are pending. Claims 1 - 8, 10, 11, 13, 14, 16 - 19, 23 - 31, 34 - 42, 45, 49 and 60 have been canceled, claims 53 - 59 have been retained, claims 9, 12, 15, 20, 21, 22, 32, 32, 33, 43, 46 - 48 and 50 - 52 have been amended, and new claims 61 - 66 have been introduced. Support for new claims 61 - 66 may be found throughout the specification and in the claims as filed. In response to Examiner Stockton's kind suggestions, a clerical error was corrected in the paragraph beginning on page 17, line 37 and ending on page 18, line 21 by a replacement paragraph. Entry of these amendments is respectfully requested.

Applicants also request, pursuant to the Official Gazette notice of March 26, 1996, which establishes guidelines for treatment of product and process claims in light of *In re Ochiai*, that claims drawn to methods (claims 52 - 59) should be included herein for consideration on the merits. Applicants request that, at the minimum, method of use claims of the same scope as the product claims be rejoined when the product claims are found to be allowable. In anticipation of the allowance of the product claims, Applicants have amended claim 52 to depend from claims 61 and 65.

I. Rejections of Claims 14 and 41 under 35 U.S.C. § 112, Second Paragraph

On page 4 of the Office Action the Examiner has rejected claims 14 and 41 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to point out and distinctly claim the subject matter which applicants regard as their invention.

In light of the foregoing claim cancellations, Applicants assert that this rejection has been rendered moot. Reconsideration and withdrawal of the rejection is respectfully requested.

II. Rejection of Claims 1, 2, 8, 10, 11, 25, 30, 33, 36, 40, 46 and 50 under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1, 2, 8, 10, 11, 25, 30, 33, 36, 40, 46 and 50 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Chen (U.S. Patent No. 6,130,239).

The Examiner asserts that Chen teaches aryloxindoles which are structurally similar to the instant claimed products. The Examiner directs Applicants' attention to Formula II in claim 34 of Chen, wherein "b" is a heterocycle, R² is halogen, R³ is alkyl, X is =CR⁵, R⁵ is -CONR⁸R⁹, R⁹ is hydrogen, R⁸ is an alkyl substituted with NR⁹R¹⁰ and R⁹ and R¹⁰ are each

alkyl. The Examiner has also directed Applicants' attention to Example 127B: a compound which bears an acyl group at the R⁵ position.

For a prior art reference to render claims unpatentable under 35 U.S.C. § 103(a), there must be (a) some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (b) a reasonable expectation of success; and (c) the reference or references combined must teach or suggest all of the claim limitations.

In light of the cancellation of certain claims, this rejection has been rendered moot with respect to claims 1, 2, 8, 10, 11, 25, 30, 36 and 40.

Applicants respectfully urge that amended claims 33, 46 and 50 and new claims 61 - 66 are patentable over Chen. Chen does not contain a suggestion or motivation for selecting R⁵ in Chen's claim 34 to be -CONR⁸R⁹, wherein R⁹ is hydrogen, R⁸ is an alkyl substituted with NR⁹R¹⁰ and R⁹ and R¹⁰ are each alkyl to construct the genus of claim 61—there are simply too many choices for R-groups in Chen's claim 34. Certainly, Chen does not provide any suggestion or motivation for selecting R⁵ in his formula to be -CONR⁸R⁹, wherein R⁹ is hydrogen and R⁸ is an alkyl substituted with -N⁺OR⁹R¹⁰. Even the Examples disclosed in Chen do not provide a suggestion or motivation to place a -CONR⁹R¹⁰ group at R⁵ in his formula. In fact, not even the Example cited by the Examiner, 127B, provides a suggestion or motivation to place a -CONR⁹R¹⁰ group at Chen's R⁵. Instead, Example 127B places an acetyl group (-C(O)CH₃) at Chen's R⁵. Accordingly, Applicants assert that Chen does not provide the requisite motivation under 35 U.S.C. § 103(a) to select the substituents now recited in new claims 61 - 66. Reconsideration and withdrawal of the rejection are therefore requested.

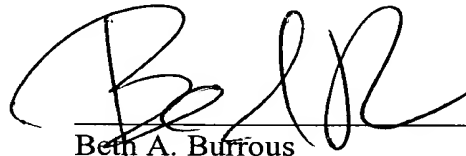
IV. Conclusion

In view of the above remarks and amendments, it is respectfully submitted that this application is in condition for allowance. Early notice to that effect is earnestly solicited. Examiner Stockton is invited to telephone the undersigned at the number listed below if she believes such would be helpful in advancing the application to issue.

Respectfully submitted,

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Date



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